

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

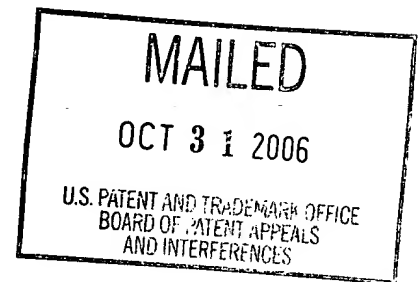
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MAKOTO SUZUKI and HARUTAKA EGUCHI

Appeal No. 2006-2648
Application No. 09/788,387

HEARD: Oct. 18, 2006



Before HAIRSTON, BARRY, and BLANKENSHIP, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

A patent examiner rejected claims 1, 4, 5, 7-9, 12-14 and 16. The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm.

I. BACKGROUND

The invention at issue on appeal concerns digital photography. Digital image data generated by an imaging device are generally stored in a built-in memory and a sub storage unit. (Spec. at 1.) The stored digital image data are read from the memory or the storage unit and displayed on a display device. (*Id.* at 2.)

According to the appellants, a display order of recorded image data is determined by sorting the data with pre-defined keys or characteristics, such as a file

name, a recordation date, etc., thereby causing a newly photographed image to be inserted at the end of the display order. (App. Br. at 2-3.) The appellants opine, "This requires a user who desires to display a particular digital image data recorded on the imaging device to have knowledge of the display order and/or search through digital images using the key or characteristics defining the display order." (*Id.* at 3.)

In contrast, an understanding of the appellants' invention can be achieved by reading the following claims:

12. An image photographing method, comprising:

detecting a photographing instruction;

displaying a screen configured by a first display area displaying an image from an image acquisition device, and a second display area displaying a sequence of image data;

generating image data from the image when detecting the photographing instruction; and

inserting the image data in a desirable position of said sequence listing of image data.

16. A computer readable storage medium storing a program executable by a computer connected with an image acquisition device to perform operations, comprising:

providing a first display area displaying an image from the image acquisition device and providing a second display area displaying a sequence of stored image data; and

acquiring the image from the image acquisition device and generating image data related to the acquired image, wherein the generated image data is automatically stored at a selected position of the displayed sequence of stored image data in accordance with a user's instruction when the image is acquired.

Claims 1, 4, 7, 8, 12, and 13 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,515,704 ("Saito"). Claims 5, 9, 14, and 16 stand rejected under 35 U.S.C. § 103(a) as obvious over Saito and U.S. Patent No. 5,943,050 ("Bullock").

II. OPINION

Our opinion addresses the claims in the following order:

- claims 1, 4, 5, 7-9, and 12-14.
- claim 16.

A. CLAIMS 1, 4, 5, 7-9, AND 12-14

"When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board

must consider the patentability of any grouped claim separately." 37 C.F.R.

§ 41.37(c)(1)(vii).

Here, the appellants argue claims 1, 4, 7, 8, 12, and 13, which are subject to the same ground of rejection, as a group. (Appeal Br. at 3-6.) At her oral hearing, the appellants' attorney confirmed that the appellants were not arguing the patentability of the dependent claims separately. Therefore, we select claim 12 as the sole claim on which to decide the appeal of the group.

"With the aforementioned representation in mind, rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the point of contention therebetween." *Ex parte Luse*, No. 2006-0721, 2006 WL 2710993, at *2 (Bd.Pat.App & Int. 2006). The examiner makes the following findings.

Sato discloses the ability to either display a newly captured image in a clockwise direction (col. 5, lines 10-16) or always display an image at a predetermined window, which is set as the initial position[] (col. 6, lines 35-39). Both of these methods are used to place a captured image in a "desirable" location within a sequence of images. The method of displaying a newly captured image in a location at a clockwise position is desirable since it serves as an efficient way of maintaining and organizing images. The method of always displaying a newly captured image at a predetermined window is desirable because the user can always recognize the last image captured at a glance (col. 6, lines 51-53). This ability to insert an image into a specified location in a sequence of images

is interpreted to meet the limitation of inserting image data in a desirable position within the sequence of image data.

(Examiner's Answer at 3-4.) The appellants argue, "unlike Sato, where insertion is restricted to specific positions, the present invention enables insertion of the image data at a desired position of the user, which is manually specified or by programming the system, to automatically place the image in the desired position." (Reply Br. at 6.)

"In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the representative claim at issue to determine its scope. Second, we determine whether the construed claim is anticipated." *Ex parte Pittaro*, No. 2005-2057, 2006 WL 1665401, at *2 (Bd.Pat.App & Int. 2006).

1. Claim Construction

"Analysis begins with a key legal question — what is the invention claimed?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification."

In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, contrary to the appellants' argument, claim 12 does not specify inserting an image in a "desired" position. To the contrary, the representative claim recites in pertinent part the following limitations: "inserting the image data in a desirable position of said sequence listing of image data." Giving the claim its broadest, reasonable construction, the limitations require inserting image data in a desirable position of a sequence of image data.

2. Anticipation Determination

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002).

"[A]nticipation is a question of fact." *Hyatt*, 211 F.3d at 1371, 54 USPQ2d at 1667 (citing *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814-15 (1869); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997)). "A reference anticipates a claim if it discloses the claimed invention 'such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.'" *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697,

1701 (Fed. Cir. 1995) (quoting *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962)).

Of course, anticipation "is not an 'ipsissimis verbis' test." *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) (citing *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479 & n.11, 1 USPQ2d 1241, 1245 & n.11 (Fed. Cir. 1986)). "An anticipatory reference . . . need not duplicate word for word what is in the claims." *Standard Havens Prods. v. Gencor Indus.*, 953 F.2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991).

Here, Sato's "FIG. 1 is a block diagram showing the arrangement of an image sensing apparatus, i.e., a digital camera. . . ." (Col. 3, ll. 19-20.) "Reference numeral [9] denotes . . . a display section for displaying image data on an LCD or the like. . . ." (*Id.* at ll. 39-42.) "Referring to FIG. 2, reference numeral 100 denotes an actual entire display screen of the display section 9, which is constituted by, e.g., an LCD; 101, a main image display portion as a window at the center of the screen, on which a photographing preview image is mainly displayed; and 102 to 113, a plurality of subwindows at the peripheral portion of the screen, on which photographed viewing thumbnail images are displayed in time series." (Col. 4, ll. 32-40.) "When the initial position of the viewing thumbnail image display is set at, e.g., the subwindow 102, the

viewing thumbnail images are sequentially displayed on the subwindows 102 to 113 in time series." (*Id.* at ll. 40-44.)

"Every patent application and reference relies to some extent upon knowledge of persons skilled in the art to complement that [which is] disclosed. . . ." *In re Bode*, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977) (quoting *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 424 (CCPA 1973)). Those persons "must be presumed to know something" about the art "apart from what the references disclose." *In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). Here, we find that those skilled in the art would have agreed with the examiner that displaying images sequentially in a time series would have "serve[d] as an efficient way of maintaining and organizing images." (Examiner's Answer at 4.) For example, such an arrangement would have tracked the chronological order in which photographs were taken.

As aforementioned, "[i]n the first embodiment [of the reference], as shown in FIG. 4, thumbnail image are sequentially additionally displayed in the clockwise direction on the subwindows at the peripheral portion of the screen every time a new image is photographed. However, [Sato's] invention is not limited to this." (Col. 6, ll. 31-35.) "For example, the latest image may be always displayed on a predetermined window set as the initial position, and the thumbnail image previously displayed on the

subwindow may be shifted in the clockwise direction and redisplayed. FIG. 8 shows this example." (*Id.* at ll. 35-40.) We find that those skilled in the art would have agreed with the examiner that always displaying the latest image in the same position would have allowed a "user [to] always recognize the last image captured at a glance. . . ." (Examiner's Answer at 4.)

Because the reference's displaying of images sequentially in a time series or always displaying the latest image in the same position would have provided the aforementioned advantages, we further find that Sato inserts image data in a desirable position of a sequence of image data.

Furthermore, "it is inappropriate for appellants to discuss in their reply brief matters not raised in . . . the principal brief[]. Reply briefs are to be used to reply to matter raised in the brief of the appellee." *Kaufman Company, Inc. v. Lantech, Inc.*, 807 F.2d 970, 973 n., 1 USPQ2d 1202, 1204 n. (Fed. Cir. 1986). "Considering an argument advanced for the first time in a reply brief . . . is not only unfair to an appellee . . . but also entails the risk of an improvident or ill-advised opinion on the legal issues tendered." *McBride v. Merrell Dow and Pharmaceuticals, Inc.*, 800 F.2d 1208, 1211 (D.C. Cir. 1986) (internal citations omitted).

Here, the appellants' reply brief newly argues that "Sato does not teach or suggest, 'first display area displaying an image from the image acquisition device' and 'second display area displaying a sequence of stored image data', as recited in each of the independent claims 1, 7, 12 and 16." (Reply Br. at 4.) Because the position set forth in the examiner's answer regarding these limitations, (Examiner's Answer at 3), is identical to that set forth in the final rejection, (Final Rej. at 3), we find nothing that would have prompted the new arguments. The arguments regarding the additional limitations of claims 1, 7, 12, and 16 could have been made in the appellants' original brief. The term "reply brief" is exactly that, a brief in reply to new rejections or new arguments set forth in an examiner's answer. The appellants may not present their arguments in a piecemeal fashion, holding back arguments until an examiner answers their original brief. Of course, the appellant is not precluded from presenting new arguments directly to the examiner for consideration as part of a continuing application. Therefore, we affirm the rejection of claim 12 and of claims 1, 4, 7, 8, and 13, which fall therewith.

Rather than arguing the patentability of claims 5, 9, and 15 separately, the appellants rely on their aforementioned argument. Having been unpersuaded by this argument, we affirm also the rejection of the latter claims.

B. CLAIM 16

The examiner finds, "Sato discloses that upon capture of the image, the thumbnail image is displayed in the selected position. Therefore, the user's instruction is . . . the user's depression of the shutter button in the operation section (12) (col. 3, lines 49-51) during acquisition of the image." (Examiner's Answer at 9.) The appellants argue that "in contrast to Sato, the present invention provides the user the capability of defining a 'selected position' at which the image is to be placed based on 'a user's instruction' after 'acquiring the image from the image acquisition device.'" (Reply Br. at 6.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the claim at issue to determine its scope. Second, we determine whether the construed claim would have been obvious.

1. Claim Construction

Here, claim 16 recites in pertinent part the following limitations: "the generated image data is automatically stored at a selected position of the displayed sequence of stored image data in accordance with a user's instruction when the image is acquired." Giving the claim its broadest, reasonable construction, the limitations require inserting

image data in a selected position of a sequence of image data in accordance with a user's instruction when the image is acquired.

2. Obviousness Determination

"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *3 (Bd.Pat.App & Int. 2004). The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1383, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, as mentioned regarding claims 1, 4, 5, 7-9, and 12-14, Sato inserts newly acquired image data in either the latest position of a sequence of in the same initial

position. Because one of those alternative insertion points must be selected, we find that the reference inserts image data in a selected position of a sequence of image data. Because such insertion is performed responsive to "determi[ing] whether photographing is performed, i.e., whether the user depresses the shutter of the operating section 12 to instruct to receive the preview image in the memory 5 (S11)," (col. 4, ll. 64-67), we further find that Sato inserts image data in a selected position of a sequence of image data in accordance with a user's instruction when the image is acquired. Therefore, we affirm the rejection of claim 16.

III. CONCLUSION

In summary, the rejection of claims 1, 4, 7, 8, 12, and 13 under § 102(e) is affirmed. The rejection of claims 5, 9, 14, and 16 under § 103(a) is also affirmed.

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, our affirmance is based only on the arguments made in the briefs. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that

AFFIRMED

KENNETH W. HAIRSTON
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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